IN THE DRAWINGS:

The Applicants have submitted formal drawings to replace the originally filed informal drawings. To address one of the Examiner's objections, the reference numeral 300' has been added to FIGURE 3B. This reference numeral has been previously disclosed in the specification on Page 40, Line 10. Therefore, no new matter has been added to the drawings as a result of this amendment.

REMARKS

Claims 1-20 are pending in the patent application (the "Application").

Claims 1-20 have been rejected.

No claims have been allowed.

Claims 1-20 remain in the Application.

Reconsideration of Claims 1-20 is respectfully requested.

I.   DRAWING OBJECTIONS

On Page 2 of the July 13, 2006 Office Action, the Examiner objected to the drawings for failing to comply with 37 C.F.R. §§ 1.84(m) and 1.84(p). The Applicants have submitted formal drawings to replace the originally filed informal drawings. To address the Examiner's objections, some elements of the invention that have been previously disclosed in the specification have been added to the drawings. Because these elements were originally present in the specification, no new matter has been added to the drawings as a result of the drawing amendments.

II.   AMENDMENTS TO THE SPECIFICATION

The specification has been amended to correct reference numerals. To address the Examiner's objections, some elements of the invention that have been previously disclosed in the drawings have been added to the specification. Because these elements were originally present in the drawings, no new matter has been added to the specification as a result of these amendments.

III. CLAIM REJECTIONS – OBVIOUSNESS UNDER 35 U.S.C. § 103

The July 13, 2006 Office Action rejected Claims 1-5, 8-15 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,393,410 to Frederick Thompson (hereafter *"Thompson"*) in view of United States Patent No. 6,275,825 to Kobayashi et al. (hereafter *"Kobayashi"*). For the reasons set forth below, the Applicants respectfully traverse the rejections of Claims 1-5, 8-15 and 18-20.

The July 13, 2006 Office Action also rejected Claims 6-7 and 16-17 under 35 U.S.C. § 103(a) as being unpatentable over *Thompson* in view of *Kobayashi* and further in view of United States Patent No. 5,729,694 to Holzrichter et al. (hereafter *"Holzrichter"*). For the reasons set forth below, the Applicants respectfully traverse the rejections of Claims 6-7 and 16-17.

During *ex parte* examinations of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of non-obviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is

entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. MPEP § 2142.

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the references."); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.").

Evidence of a motivation to combine prior art references must be clear and particular if the trap of "hindsight" is to be avoided. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614

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(Fed. Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be "clear and particular." "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'"). *In re Roufett*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) ("[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'")

Applicants respectfully submit that the Patent Office has not established a *prima facie* case of obviousness with respect to the Applicants' invention. The Applicants direct the Examiner's attention to Claim 1 which shows novel and unique features:

> 1.   (Previously Presented)   For use over a global communications network having company nodes and constituency nodes associated therewith, an electronic commerce system comprising:
>
> a data repository that is operable to store data files associated with said company nodes, wherein said company nodes populate respective associated data files with company information wherein each set of said company information relates to a specific company that is represented by a specific company node;
>
> wherein at least one company node is operable to modify said company information that is stored in said data files and is operable to control when selected portions of company information in said data files are made available to said constituency nodes; and
>
> a communications controller that is operable to (i) propagate communication interfaces accessible by said constituency nodes with selected portions of said company information under control of said company nodes, and (ii) gather feedback information representative of constituency response to said constituency nodes accessing said communication interfaces. (Emphasis added).

The Applicants acknowledge that the teachings of *Thompson* are broadly directed to an electronic commerce system for use over a global communications network, such as the Internet. In particular, *Thompson* is directed to a process for estimating construction projects over the network. The title of the *Thompson* patent is "Process and a System for Listing Information Relating to a Construction Project Over a Computer Network." (Emphasis added). It is clear that the *Thompson* reference discloses only the use of construction project information. The *Thompson* construction bidding scheme enables a party who controls a construction project to post a request for a proposal for all or a portion of the construction project. In the *Thompson* system, the information relating to the construction projects is sold to purchasers who request the information.

"System host 15 runs a program that controls the process for displaying quantities, estimates, bids, project schedules, and shop drawings on construction projects stored in the database 30 over the computer network. Through a series of remote computers, a series of different purchasers can log into server 10 to review these construction projects and to purchase information relating to these construction projects on web-pages 35." (*Thompson*, Column 2, Lines 45-52).

"Next, in step 240 the purchaser agrees to purchase this project wherein the purchaser is next directed to step 250 to enter in the purchaser's purchasing information in a webpage shown in FIG.9." (*Thompson*, Column 4, Lines 3-6). "Next, in step 260 the purchaser downloads the information that he or she purchased. Essentially the information purchased by the user is either quantities, estimates, bids, project schedules, or shop drawings." (*Thompson*, Column 4, Lines 12-15).

Therefore, in contrast to the Applicants' invention, the *Thompson* system sells information to purchasers. Using the purchased information, the purchasers (e.g., contractors, sub-contractors) may or may not submit responses that relate to the construction project in question. The responses may respond completely or incompletely. According to *Thompson*, the controlling party (or some agent thereof) may have supervisory control over acceptance or rejection of the response (or portions thereof) that is received from the purchaser of the construction project information.

In the system described by the *Thompson* reference, the information that is purchased by the purchasers is owned by the purchasers. Therefore, the information is not subject to further control or modification by the controlling party who sold the information to the purchasers.

The *Thompson* reference does not provide, teach or suggest the Applicants' electronic commerce system that has a data repository that is populated with company information by the company nodes, wherein each set of the company information relates to a specific company that is represented by a specific company node.

The *Thompson* reference does not provide, teach or suggest the Applicants' electronic commerce system wherein at least one company node is operable to modify the company information that is stored in the data files and is operable to control when selected portions of the company information in the data files are made available to the constituency nodes.

The *Thompson* reference does not provide, teach or suggest the Applicants' electronic commerce system that has a communications controller operable to propagate communication interfaces accessible by constituency nodes with selected portions of the company information

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under control of the company nodes, or to gather feedback information representative of constituency response to the constituency nodes accessing the communication interfaces.

On Page 4 of the July 13, 2006 Office Action, the Examiner stated "Thompson discloses an electronic commerce system for use over a global communication network (i.e., the internet) having company nodes (i.e., the owner of a project such as an architect or contractor) and constituency nodes (i.e., a purchaser such as a contractor or engineer) associated therewith (see Abstract); . . . " (July 13, 2006 Office Action, Page 4, Lines 4-7). The Applicants respectfully traverse the Examiner's assertion that the *Thompson* reference discloses a network that has company nodes as the term "company nodes" is used by the Applicants.

First, it is clear that the *Thompson* reference does not disclose or teach the use of company information. It is very clear that all of the information that is exchanged through the *Thompson* server 10 is construction project information. The Applicants respectfully submit that the meaning of the term "construction project information" is very limited to a particular type of information. The term "construction project information" does not generally describe the information that is referred to as "company information." The *Thompson* reference clearly describes what *Thompson* means by the term "information relating to a construction project." The term "information relating to a construction project" refers to shop drawings, project schedules, construction documents, costs, due dates, etc. (*Thompson*, Column 2, Line 56 to Column 3, Line 1; Column 3, Lines 38-45). This type of information is too limited to be accurately described as "company information that relates to a specific company." The term "construction project

information" relates to a specific "construction project" and not to a "specific company." More than one specific company may be engaged to work on the same construction project (e.g., main contractor, sub-contractors, materialmen). Therefore, the term "construction project information" is not synonymous with the term "company information."

Second, because the *Thompson* reference does not disclose or teach the use of company information, the *Thompson* reference also does not disclose or teach the concept of a company node. The *Thompson* reference states that "Through a series of remote computers, a series of different purchasers can log into server 10 to review these construction projects and to purchase information relating to these construction projects on web-pages 35. These purchasers could be an architect 40, a general contractor 50, a construction owner 60, a construction engineer 70, a subcontractor 80, a construction supplier 90 or a builder 95." (*Thompson*, Column 2, Lines 48-55). All of the nodes described in the *Thompson* reference are nodes of purchasers of construction project information. That is, all of the nodes described in the *Thompson* reference are constituency nodes. None of the constituency nodes that are identified in the *Thompson* reference (40, 50, 60, 70, 80, 90, 95) provide any company information. They only receive and work with construction project information. Therefore, there are no company nodes described in the *Thompson* reference.

Third, because the *Thompson* reference does not disclose or teach the use of company nodes, the *Thompson* reference also does not disclose or teach the concept of a company node that modifies company information and that controls when selected portions of the company information are made available to the constituency nodes.

On Page 4 of the July 13, 2006 Office Action, the Examiner stated that the *Thompson* system comprises "a data repository (col. 2, lines 40-45) that is operable to store data files associated with said company nodes, wherein said company nodes populate respective associated data files with company information wherein each set of said company information relates to a specific company that is represented by a specific company node (i.e., information about the construction projects)" (July 13, 2004 Office Action, Page 4, Lines 8-12). For the reasons previously set forth, the Applicants respectfully traverse this assertion of the Examiner.

As previously mentioned, "information about the construction projects" is not "company information." The constituency nodes described by the *Thompson* reference are not "company nodes" Therefore, the data repository of *Thompson* (data storage device 25, database 30) do not contain data files that contain company information.

On Page 4 of the July 13, 2006 Office Action, the Examiner also stated that the *Thompson* system comprises a system "wherein at least one company node is operable to modify said company information that is stored in said data files (col. 3, lines 46-55 – note the administrative team/user is able to change and update the information); (July 13, 2004 Office Action, Page 4, Lines 13-15). For the reasons previously set forth, the Applicants respectfully traverse this assertion of the Examiner. It is clear from the cited portion of the *Thompson* reference that the information referred to "project information" and not company information. (*Thompson*, Column 3, Lines 38-48).

On Page 4 of the July 13, 2006 Office Action, the Examiner also stated that the *Thompson* system comprises "a communications controller (20) that is operable (i) to propagate

communications interfaces accessible by said constituency nodes with selected portions of said commercial information (i.e., the construction project) under control of said company nodes (col. 3, lines 29-36), and (ii) gather feedback information (i.e., the response of the sub-contractors) representative of constituency response to said constituency nodes accessing said communication interfaces (col. 4, lines 20-49). (July 13, 2004 Office Action, Page 4, Lines 13-15). For the reasons previously set forth, the Applicants respectfully traverse this assertion of the Examiner.

The communication controller that the Applicants claim in Claim 1 is operable to propagate communication interfaces accessible by the constituency nodes with selected portions of company information under control of the company nodes. The information that is controlled by the company nodes is "company information." The term "commercial information" is not synonymous with the term "company information." For the reasons previously set forth, the term "company information" is not synonymous with the term "construction project information."

The Examiner stated that "Thompson does not expressly show wherein each set of said company information relates to a specific company that is represented by a specific company node, but rather that the data files contain company information relating to construction project presented by the company (col. 2, lines 36-39)." (July 13, 2006 Office Action, Page 5, Lines 1-4). The Examiner stated that the "company information" that is stored in the data depository 125 of the Applicants' invention is to be given little patentable weight because (according to the Examiner) the information is non-functional descriptive material.

The Applicants respectfully traverse this assertion of the Examiner. The content of the "data files" is very pertinent to the function of the present invention. Unlike the "construction project data" disclosed in the *Thompson* reference, the term "company information" refers to information about a specific company that is represented by a specific company node. "[T]he company node is also operable to store, index and relate the company's responses, detailing the past, present and future of the company and its relevant industry, all in the data depository." (Specification, Page 6, Lines 6-9). The "company information" may comprise "sales tools, marketing tools, billing tools, business intelligence, reporting, sales commissions, etc." (Specification, Page 26, Lines 4-6). The "company information" may comprise information about the company that is required to be disclosed by the Securities and Exchange Commission ("SEC"). (Specification, Page 3, Line 3 to Page 4, Line 5).

The *Thompson* device does not disclose or utilize any "company information" of the type disclosed and claimed by the Applicants. Therefore, the *Thompson* device is not capable of performing the functions that are performed by the Applicants' invention. The Applicants respectfully submit that the "company information" contained within the "data files" of the Applicants' invention is not "non-functional" descriptive material. The "company information" is necessary to perform the functions of the invention. The Applicants' invention (comprising a hardware structure that contains and uses "company information") is not suggested by or hinted at by the structure of the *Thompson* device (that does not contain any "company information" as described and claimed by the Applicants).

As set forth in the Summary of the Invention of the specification of the patent application, a primary object is to provide an electronic commerce system for monitoring communication of information by a company node to constituency nodes and analyzing constituency understanding and reaction to such information communication. The communications controller (and associated data repository), advantageously provide an interactive system that enables the company to generate and near-continuously communicate company information to its constituency via the global communications network. The company information in the present invention is not sold to purchasers. The company information is owned by the company. The company information is therefore subject to further control or modification by the company's authorized representatives.

An important aspect of the present invention is the ability of the company node to control when publication (*e.g.*, to fairly disseminate, distribute or otherwise make available) of at least selected portions of the company information stored in the data repository is available to the constituencies. This may advantageously be accomplished through the communications controller. In the *Thompson* system the distribution of information occurs only after the information has been paid for by a purchaser. The *Thompson* system operates as a sales tool for selling information.

The Applicants' contention is that Claim 1 recites "a communication controller that is operable to (i) propagate communication interfaces by said constituency nodes with selected portions of said company information under control of said company nodes . . . . " (Claim 1, Emphasis added). Because the *Thompson* reference does not disclose "company information"

the *Thompson* reference does not suggest the claim limitations that are set forth in Claim 1. Any construction project information that is purchased by a purchaser in the *Thompson* system (a constituency node) may be controlled and modified by the purchaser. But the purchaser in the *Thompson* system does not have the ability to control the publication of "company information" that remains under the direction of a company node.

The Examiner also stated that "Thompson does not expressly show wherein at least one company node is operable to control when selected portions of company information in said data files are made available to said constituency nodes. However, Kobayashi, dealing with the same problem of access to files, discloses a method and system for controlling access to various features of a software application, including wherein the software controls when selected portions of information in data files are made available to constituency nodes, i.e., controlling access to portions of information contain in databases (see, e.g., Abstract, col. 4, lines 8-31 and col. 10, line 44 through col. 11, line 16)." (July 13, 2006 Office Action, Page 5, Lines 14-21). The Examiner stated that it would have been obvious to combine the teachings of the Kobayashi reference with the teachings of the Thompson reference. (July 13, 2006 Office Action, Page 6, Lines 1-6).

For the reasons set forth below, the Applicants respectfully traverse the assertion of the Examiner that Claim 1 of the Applicants' invention is obvious in view of the combination of the *Thompson* reference and the *Kobayashi* reference.

The *Kobayashi* reference describes a data access control apparatus that limits a user's access to data in accordance with the user's data access authorization. When a user logs in to the *Kobayashi*

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system, the system automatically looks up stored information that describes an "access right" attribute that has been previously authorized and assigned to the user. The *Kobayashi* system then allows the user to only access authorized portions of a database in accordance with the user's "access right" attribute. The *Kobayashi* "access right" attributes function as access passwords.

The *Kobayashi* reference does not describe a "company node" that is operable to control when selected portions of company information are to be made available to constituency nodes. The *Kobayashi* system regulates the access of users to the various locations in a database based on the user's "access right" attributes. The database locations of *Kobayashi* are either accessed or not accessed depending on whether a user has an authorized "access right" attribute (password).

There is nothing in the *Kobayashi* reference that discloses or teaches the concept of a "company node" that determines what information will be disclosed (amount of disclosed information) and when the information will be disclosed (timing of information disclosure). The *Kobayashi* users are able to access all of their authorized database locations at any time. The *Kobayashi* system regulates who may have authorized access to information. The *Kobayashi* system does not regulate withholding the publication of information and does not regulate the timing of the publication of information.

The Applicants respectfully traverse the Examiner's assertion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system taught by *Thompson* to include the system taught by *Kobayashi*.

First, the supposed motivation to "allow for authorized users to have access to certain

information based on security clearances and the like" is very general and does not specifically suggest combining the teachings of the *Kobayashi* reference with the teachings of the *Thompson* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The desire to obtain "access for authorized users" is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings.

The Applicants respectfully submit that one skilled in the art would not attempt to combine the method that *Kobayashi* uses with the *Thompson* system. The Applicants respectfully submit that a combination of the *Kobayashi* system and the *Thompson* system would be unworkable. For this reason there would be no suggestion or motivation to combine the teachings of the *Kobayashi* reference with the teachings of the *Thompson* reference.

The Applicant respectfully submits that the alleged motivation to combine references presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicant respectfully submits that the alleged motivation to combine references is not clear and particular. The Examiner stated that "Doing so [combining the references] would allow for authorized users to have access to certain information based on security clearances and the like, while ensuring that unauthorized users do not have access." (July 13, 2006 Office Action, Page 6, Lines 4-6). The Applicants respectfully traverse this assertion of the Examiner. The fact that two references are concerned with the same general technical area does not without more provide a "clear and particular" motivation to combine the references. The Applicants respectfully submit

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that the alleged motivation to combine references has been assumed by "hindsight" in light of the existence of the Applicants' invention.

Even if the *Kobayashi* reference could properly be combined with the *Thompson* reference (which the Applicants deny), the combination would not teach, suggest, or even hint at the Applicants's invention. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. In the present case, the *Kobayashi* reference and the *Thompson* reference in combination would not teach or suggest all the claim limitations of the Applicants' invention.

The only way one can arrive at the Applicants' invention is by looking backward from the *Thompson* reference and the *Kobayashi* reference. It cannot be said that one of ordinary skill in the pertinent art would be presumed to know of the teachings of *Thompson* and the teachings of *Kobayashi* and could solve the same or a similar problem as that addressed by the Applicants. *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 906-07, 225 U.S.P.Q. 20, 25 (Fed. Cir.), *cert. denied*, 474 U.S. 843 (1985); *In re Sernaker*, 702 F.2d 989, 995, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983). The requisite motivation does not stem from any of these teachings, from the perspective of one of ordinary skill in the art, to arrive at the Applicants' invention. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

The *Thompson* reference and the *Kobayashi* reference do not disclose, suggest or even hint at the Applicants' concept of controlling the disclosure of "company information" in an electronic commerce system. The *Thompson* reference and the *Kobayashi* reference do not provide, teach or suggest the Applicants' electronic commerce system having as recited in Claim 1 (and Claims 2-5 and 8-10 depending from Claim 1). In relation to the differences between Claim 1 and *Thompson* and *Kobayashi*, Claims 11 and 20 may be said to include analogous limitations to those found in Claim 1, and, as such, are also not taught, suggested, or hinted at by the *Thompson* reference or by the *Kobayashi* reference (and Claims 12-15, 18 and 19 depending from Claim 11).

Simply stated, Claims 1-5, 8-15 and 18-20 are not *prima facie* obvious. Therefore the Applicants therefore respectfully submit that Claims 1-5, 8-15 and 18-20 are not obvious under 35 U.S.C. § 103(a) in view of the *Thompson* reference or in view of the *Kobayashi* reference, whether taken singly or in combination. For the foregoing reasons, the Applicants respectfully request withdrawal of the § 103(a) rejections of Claims 1-5, 8-15 and 18-20.

The July 13, 2006 Office Action also rejected Claims 6-7 and 16-17 under 35 U.S.C. § 103(a) as being unpatentable over *Thompson* in view of *Kobayashi* and further in view of United States Patent No. 5,729,694 to Holzrichter et al. (hereafter "*Holzrichter*"). The Applicants respectfully traverse the obviousness rejections of Claims 6-7 and 16-17. The Applicants hereby incorporate by reference all of the arguments previously made in connection with Applicants' position that Claims 1-5, 8-15 and 18-20 are patentable.

As described above, Claims 1 and 11 are patentable over the cited art. As a result, Claims 6, 7, 16 and 17 are patentable due to their dependence from allowable base claims. Accordingly, the Applicants respectfully request withdrawal of the § 103(a) rejection of Claims 6, 7, 16 and 17.

Further, the Applicants respectfully traverse the Examiner's assertion that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by the *Thompson-Kobayashi* combination to utilize the speaker identification teachings as taught by *Holzrichter*.

First, the supposed motivation to provide the *Thompson-Kobayashi* combination with "the ability to use interactive voice recognition" is very general and does not specifically suggest combining the teachings of the *Thompson-Kobayashi* combination with the teachings of the *Holzrichter* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The desire to obtain "the ability to use interactive voice recognition" is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings. *Holzrichter* does not disclose or even hint at the steps of the method claimed in independent Claim 1 from which Claim 6 indirectly depends.

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.,* 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching

or suggestion, in the prior art, to combine the references."); *In re Rouffet*, 149 F.3d 1350, 1355-56,

47 USPQ2d 1453, 1456 (Fed.Cir. 1998) ("When a rejection depends on a combination of prior art

references, there must be some teaching, or motivation to combine the references.")

Evidence of a motivation to combine prior art references must be clear and particular

if the trap of "hindsight" is to be avoided. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614

(Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references

must be "clear and particular." "Broad conclusory statements regarding the teaching of multiple

references, standing alone, are not 'evidence.'"). *In re Roufett*, 149 F.3d 1350, 1357, 47 USPQ2d

1453, 1457 (Fed.Cir. 1998) ("[R]ejecting patents solely by finding prior art corollaries for the

claimed elements would permit an examiner to use the claimed invention itself as a blueprint for

piecing together elements in the prior art to defeat the patentability of the claimed invention. Such

an approach would be 'an illogical and inappropriate process by which to determine patentability.'")

The Applicants respectfully submit that the alleged motivation to combine references

presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie*

obviousness. The Applicants respectfully submit that the alleged motivation to combine references

is not clear and particular. The Examiner stated that "At the time of the invention, it would have

been obvious to a person of ordinary skill in the art to have modified the teachings of Holzrichter

to allow for the ability to use an interactive voice recognition to identify designated personnel and

to translate selected portions of the information from a first language into a second language. Doing

so would allow for the capability of data being accessed by those denied the use of their hands and

thereby precluded from using a conventional computer terminal." (July 13, 2006 Office Action, Page 8, Lines 1-6). The Applicants respectfully traverse this assertion of the Examiner. The fact that two references are concerned with the same general technical area does not without more provide a "clear and particular" motivation to combine the references. The Applicants respectfully submit that the alleged motivation to combine references has been assumed by "hindsight" in light of the existence of the Applicants' invention.

Even if the *Holzrichter* reference could be properly combined with the *Thompson-Kobayashi* combination (which the Applicants deny), the combination would not teach, suggest, or even hint at the Applicants' invention as set forth in Claims 6, 7, 16 and 17. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an Applicants' disclosure.

In the present case, the *Thompson* reference and the *Kobayashi* reference and the *Holzrichter* reference in combination would not teach or suggest all the claim limitations of Claims 6, 7, 16 and 17 of the Applicants' invention. This is because, as previously described, the *Thompson* reference and the *Kobayashi* reference do not disclose, suggest or even hint at the Applicants' concept of controlling the disclosure of "company information" in an electronic commerce system.

The Applicants respectfully assert that Claims 6, 7, 16 and 17 were improperly rejected

by the July 13, 2006 Office Action. The Applicants respectfully request that the rejections of

Claims 6, 7, 16 and 17 be withdrawn and that Claims 6, 7, 16 and 17 be allowed.

IV. CONCLUSION

The Applicants respectfully submit that Claims 1-20 present patentable subject matter over

the prior art of record. The Applicants respectfully request that Claims 1-20 be passed to allowance.

The Applicants's attorney has made the remarks and arguments set forth above in order to

place this Application in condition for allowance. In the alternative, the Applicants' attorney has

made the remarks and arguments to properly frame the issues for appeal. In this response the

Applicants make no admission concerning any now moot rejection or objection, and affirmatively

deny any position, statement or averment of the Examiner that was not specifically addressed herein.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com.*

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

Date: OCT. 13, 2006

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